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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/123,109	07/27/1998	JAMES DUKE BOND	RIC-97-120	5163

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EXAMINER

GAUTHIER, GERALD

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 04/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/123,109

Applicant(s)

BOND ET AL.

Examiner

Gerald Gauthier

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. **Claims 1, 2, 6-10, 14-17, 19, 20 and 24-26** are rejected under 35 U.S.C. 102(e) as being anticipated by Gow (U. S. 5,828,732).

Regarding **claims 1 and 19**, Gow discloses a system for recording a personal greeting associated with a pre-paid telephone calling card, comprising:

a data storage system for storing data corresponding to a pre-paid telephone calling card and a personal greeting related to said pre-paid telephone calling card (1 and 4 on FIG. 1) [The access control stores data on the pre-paid card and the message recording stores the personal greeting]; and

a pre-paid telephone calling card processing system coupled to said data storage system (1 and 4 on FIG. 1) and configured to receive a request to record said personal greeting during a setup call over a telephone network (column 3, lines 10-15) [The personal greeting is received as an incoming call] and to cause said personal greeting to be recorded during said setup call (column 3, lines 49-54)[The personal greeting is recorded during the call].

Regarding **claims 2 and 20**, Gow discloses a system, wherein said data storage system and said pre-paid calling card processing system are remotely located (1 and 4 on FIG. 1).

Regarding **claims 6, 14 and 24**, Gow discloses a system, wherein said pre-paid telephone calling card processing system causes said personal greeting to be recorded within said data storage system in accordance with a card identifier corresponding to said pre-paid telephone calling card (column 4, lines 56-60).

Regarding **claims 7 and 25**, Gow discloses a system; further comprising a voice data storage facility coupled to said pre-paid telephone calling card processing system (1 and 4 on FIG. 1) and to said data storage system, and operative to store said personal greeting based on a card identifier corresponding to said pre-paid telephone calling card (column 4, lines 11-15).

Regarding **claims 8 and 26**, Gow discloses a system, further comprising a voice response system coupled to said pre-paid calling card processing system and configured to prompt a caller to record said personal greeting via at least one voice prompt during said setup call over said telephone network (column 43, lines 40-55).

Regarding **claim 9**, Gow discloses a system, wherein said personal greeting is to be played back via said pre-paid telephone calling processing system during an access call related to said pre-paid telephone calling card, said access call made in accordance with the use of said pre-paid telephone calling card (column 4, lines 60-67).

Regarding **claim 10**, Gow discloses a method for recording a personal greeting associated with a pre-paid telephone calling card, comprising the steps of:

storing data corresponding to a pre-paid telephone calling card and a personal greeting to be associated with pre-paid telephone calling card (column 4, lines 10-15) [The control device and the replaying device handle the data storage];

receiving a request to record said personal greeting during a setup call over a telephone network (column 3, lines 15-17) [The table describe the request for recording]; and

causing said personal greeting to be recorded during said setup call (column 3, lines 10-15) [The personal greeting is recorded after the tone], said personal greeting to be played back during an access call related to the use of said pre-paid telephone calling card (column 4, lines 60-67) [The recipient using the right pin will listen to the greeting].

Regarding **claim 15**, Gow discloses a method, wherein said personal greeting stored during said causing step is to be played back automatically during an access call related to said pre-paid telephone calling card (column 4, lines 56-60).

Regarding **claim 16**, Gow discloses a method of using a pre-paid telephone calling card, comprising the steps of:

accessing a pre-paid telephone calling card processing system during a pre-paid telephone calling card setup call via a telephone network (column 3, lines 10-15) [The personal greeting is received as an incoming call];

entering a card identifier corresponding to data addressable by said pre-paid telephone calling card processing system (column 3, lines 49-55) [The pin is assigned to each caller before recording];

recording a personal greeting during said setup call, said personal greeting being addressable by said pre-paid telephone calling card processing system during a subsequent telephone service access call (column 3, lines 15-45) [The recording procedure is explain in the table].

Regarding **claim 17**, Gow discloses a method, wherein said personal greeting is stored in a data storage system in accordance with said card identifier (column 4, lines 56-60).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 3, 4, 11, 12, 21, 22, 27, 28 and 30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gow in view of Bruno et al. (U. S. 5,991,380).

Regarding **claims 3, 11 and 21**, Gow as applied to **claims 1, 10 and 19** above differ from **claims 3, 11 and 21** in that it fails to disclose a quantity corresponding to a number of service units.

However, Bruno teaches a system, wherein said data corresponding to said pre-paid telephone calling card includes a quantity corresponding to a number of service units available to be used to make at least one call in relation to said pre-paid telephone calling card (column 2, lines 22-27).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use a quantity corresponding to a number of service units of Bruno in the invention of Gow.

Doing so would provide access to telecommunications services.

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Regarding **claims 4, 12 and 22**, Gow as applied to **claims 1, 10 and 19** above differ from **claims 4, 12 and 22** in that it fails to disclose at least one call is a long distance telephone call.

However, Bruno teaches a system, wherein said at least one call is a long distance telephone call (column 2, lines 27-33).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use one long distance telephone call of Bruno in the invention of Gow.

Doing so would provide access through a Local Exchange Carrier.

Regarding **claim 27**, Gow discloses a method for facilitating the use of a pre-paid telephone calling card having an associated pre-recorded personal greeting, comprising:

storing data corresponding to a pre-paid telephone calling card and to a personal greeting related to said pre-paid telephone calling card (column 4, lines 10-15) [The control device and the replaying device handle the data storage]; and

causing said personal greeting to be played during said access call (column 3, lines 10-15) [The personal greeting is recorded after the tone].

Gow fails to disclose an outbound telephone call.

Bruno teaches receiving a request to make an outbound telephone call in relation to said pre-paid telephone calling card during an access call over a telephone network (column 3, lines 18-24) [The request to make a telephone call].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use an outbound telephone call of Bruno in the invention of Gow.

Doing so would provide the particular service requested.

Regarding **claim 28**, Gow and Bruno as applied to **claim 27** above differ from **claim 28** in that it fails to disclose a quantity corresponding to a number of service units.

However, Bruno teaches a method, wherein said data corresponding to said pre-paid telephone calling card includes a quantity corresponding to a number of service units available to be used to make said outbound call in relation to said pre-paid telephone calling card (column 2, lines 22-27).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use a quantity corresponding to a number of service units of Bruno in the invention.

Doing so would provide access to telecommunications services.

Regarding **claim 30**, Gow and Bruno as applied to **claim 27** above differ from **claim 30**. In addition, Gow discloses a method, wherein said causing step causes said personal greeting to be played back in accordance with a card identifier corresponding to said pre-paid telephone calling card (column 4, lines 60-67).

5. **Claims 5, 13, 18 and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gow in view of Nguyen et al. (U. S. 5,815,561).

Regarding **claims 5, 13 and 23**, Gow as applied to **claims 1, 10 and 19** above differ from **claims 5, 13 and 23** in that it fails to disclose service units correspond to telephone call service minutes.

However, Nguyen teaches a system, wherein said service units correspond to telephone call service minutes (column 13, lines 30-36).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use service units correspond to telephone call service minutes of Nguyen in the invention of Gow.

Doing so would provide a cost demarcated communication.

Regarding **claim 18**, Gow as applied to **claim 16** above differ from **claim 18** in that it fails to disclose the publicly switched telephone network.

However, Nguyen teaches a method, wherein said telephone network is the publicly switched telephone network (PSTN) (column 10, lines 3-5).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the publicly switched telephone network of Nguyen in the invention of Gow.

Doing so would illustrate a typical local exchange carrier.

6. **Claim 29** is rejected under 35 U.S.C. 103(a) as being unpatentable over Gow in view of Bruno and in further view of Nguyen.

Gow and Bruno as applied to **claim 27** above differ from **claim 29** in that it fails to disclose service units correspond to telephone call service minutes.

However, Nguyen teaches a method, wherein said service units correspond to telephone call service minutes (column 13, lines 30-36).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use service units correspond to telephone call service minutes of Nguyen in the invention of Gow.

Doing so would provide a cost demarcated communication.

7. **Claims 31-33** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bruno in view of Gow.

Regarding **claim 31**, Bruno discloses a method of using a pre-paid telephone calling card, comprising the steps of:

accessing a pre-paid telephone calling card processing system during a telephone service access call via a telephone network (column 3, lines 12-14) [The caller accesses the carrier network];

entering a card identifier corresponding to data addressable by said pre-paid telephone calling card processing system (column 3, lines 12-18) [The account is validated].

Bruno fails to disclose personal greeting associated with said pre-paid telephone calling card.

Gow teaches retrieving a pre-recorded personal greeting associated with said pre-paid telephone calling card based on said card identifier entered during said entering step (column 4, lines 56-60) [The caller has to enter a pin]; and

playing said pre-recorded personal greeting associated with said pre-paid telephone calling card during said telephone service access call (column 4, lines 60-67) [The caller hears the greeting].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use a personal greeting associated with said pre-paid telephone calling card of Gow in the invention of Bruno.

Doing so would allow the recipient to listen to the greeting.

Regarding **claim 32**, Bruno and Gow as applied to **claim 31** above differ from **claim 30**. In addition, Bruno discloses a method, further comprising the step of entering a terminating telephone number to which an outbound call will be placed automatically after said pre-recorded personal greeting has been played (column 3, lines 51-54).

Regarding **claim 31**, Bruno and Gow as applied to **claim 31** above differ from **claim 30**. In addition, Bruno discloses a method according, wherein said accessing and entering steps are carried out remotely from said retrieving and playing steps (column 2, lines 22-27).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Walker et al. is cited for a method for awarding and redeeming prepaid telephone time (FIG. 1).


Moen et al. is cited for a method of providing message service for limited access telecommunications (FIG. 1).

Fougnyes et al. is cited for a prepaid cellular telecommunications system (FIG. 1).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (703) 305-0981. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.


g.g.
March 25, 2002

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